

### Remarks

Claims 1, 3-11, 13 and 18-21 are pending in the application. Claims 4 and 9 are allowed. Claims 18-21 have been withdrawn from consideration by the Examiner. Claims 1, 3, 5-8, 10, 11 and 13 stand rejected. Claims 18-21 have been withdrawn from consideration by the Examiner. Favorable reconsideration is respectfully requested.

The undersigned thanks Examiner Ruthkosky for the courtesy of a personal interview on February 10, 2005.

### Objection to the Specification

The amendment filed 8/2/2004 was objected to under 35 USC 132 as introducing new matter into the disclosure. Specifically, the Examiner states that the disclosure lacks support for claim limitations "about 140°C or greater and less than 220°C" and "without baking the separator."

The Applicant respectfully traverses. As discussed during the above-noted interview, there is supporting disclosure in the present specification for "without baking the separator" in the paragraph bridging pages 26-27.

With regard to "about 140°C or greater and less than 220°C," "about" has been deleted from the claims. Concerning "less than 220°C," the Applicant notes that courts have held that "broadly articulated rules are particularly inappropriate" in applying the description requirement to narrowing claims involving ranges and the like. See, e.g., *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), *appeal after remand*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981). In the latter case, the court upheld a claim reciting "between 35% and 60%" where the disclosure described "25 to 60%." The present claims are analogous. Withdrawal of the objection is therefore respectfully requested.

### Claim rejections

#### Section 112

Claims 10, 11 and 13 were rejected under 35 USC 112, 2<sup>nd</sup> paragraph, on grounds that the specification lacks support for the limitation "without baking the separator." Withdrawal of this rejection is respectfully requested in view of the

supporting disclosure in the present specification in the paragraph bridging pages 26-27.

### Section 102

Claim 13 was rejected under 35 USC 102(b) as being anticipated by Taylor (US 4,592,968). However, the asserted rejection is unsupported by Taylor for at least the reason that Taylor does not disclose "completing manufacture of the separator without baking the separator" as required by claim 13. Instead, Taylor only discloses a process that includes carbonization, which cannot be accomplished without baking. See, e.g., Taylor, col. 6, line 55. Accordingly, withdrawal of the rejection of claim 13 as anticipated by Taylor is respectfully requested.

### Section 103

Claims 1, 3, 5-8 and 11 were rejected under 35 USC 103(a) as being unpatentable over Kougrou (JP 59042781). However, Kougrou does not support the asserted rejection for at least the reason that Kougrou does not teach or suggest "heat press forming ... at a temperature which is 140°C or greater and less than 220°C," as required by claim 1 and consequently also by claims 3, 5-8 and 11 dependent thereon. Instead, Kougrou teaches away from the claimed invention by only disclosing heating at a temperature range from 220°C to 270°C after a preheating step at 200°C to produce a "carbonaceous material." Assuming that "carbonaceous material" corresponds to a carbonized or graphitized material, it is well known that such carbonized or graphitized material is not formed from the raw material recited in present claim 1 at temperatures below 220° C; consequently, the temperature ranges and end product of Kougrou are completely inconsistent with the method recited in present claim 1.

It is further noted that the heat range disclosed in Kougrou's abstract and referred to by the Examiner (i.e. 180°C to 250°C) is not applied during a heat press forming step as recited in claim 1, but to a "molded body" after it is "sliced."

Accordingly, claim 1 and claims dependent thereon are allowable over Kougorou. Withdrawal of the rejection of claims 1, 3, 5-8 and 11 as being unpatentable over Kougorou is therefore respectfully requested.

Claims 3, 5 and 7-8 were rejected under 35 USC 103(a) as being unpatentable over Kougorou in view of Sandelli et al. (US 4,646,956). Claims 3, 5 and 7-8 depend on claim 1 and therefore include its features. As noted above, Kougorou does not teach or suggest the invention as recited in present claim 1. Sandelli et al. does not remedy the deficiencies in Kougorou with respect to claim 1 for at least the reason that, like Kougorou, Sandelli et al. is silent as to "heat press forming ... at a temperature which is 140°C or greater and less than 220°C." Accordingly, claim 1 is allowable over the combination of Kougorou and Sandelli et al. Consequently, claims 3, 5 and 7-8 are likewise allowable over Kougorou and Sandelli et al. for at least the reasons discussed in connection with claim 1. Withdrawal of the rejection of claims 3, 5 and 7-8 as unpatentable over Kougorou in view of Sandelli et al. is therefore respectfully requested.

Claims 1, 3, 5-8 and 11 were further rejected under 35 USC 103(a) as being unpatentable over Sandelli et al. in view of Hidekuni (JP 08-151,461). Deficiencies in Sandelli et al. with respect to claim 1 have been discussed above. Hidekuni does not cure deficiencies in Sandelli et al. for at least the reason that Hidekuni does not teach or suggest "heat press forming ... at a temperature which is 140°C or greater and less than 220°C," as required by claim 1. Instead, Hidekuni only discloses that a forming board including carbon fiber and solid phenol resin is burned at a temperature range from 1000°C to 3000°C, which far exceeds the temperature range recited in present claim 1. Accordingly, claim 1 and claims dependent thereon are allowable over Sandelli et al. and Hidekuni. Withdrawal of the rejection of claims 1, 3, 5-8 and 11 as being unpatentable over Sandelli et al. in view of Hidekuni is therefore respectfully requested.

Claims 1, 3, 5-8 and 11 were further rejected under 35 USC 103(a) as being unpatentable over Kougorou in view of Hidekuni. For at least reasons discussed above, both Kougorou and Hidekuni fail to teach or suggest the invention recited in present claim 1. Withdrawal of the rejection of claims 1, 3, 5-8 and 11 as being unpatentable over Kougorou in view of Hidekuni is therefore respectfully requested.

Claim 10 was rejected under 35 USC 103(a) as being unpatentable over Sandelli et al., or Kougorou, in view of JP 08-151,461 (Hidekuni) and further in view of Taylor. However, the above-cited references cannot support the asserted rejected, either singly or in combination, for at least the reason that none teaches or suggests "completing manufacture of the separator without baking the separator," as required by claim 10. Instead, each teaches away from the invention recited in present claim 10, by disclosing only a carbonized end product. Accordingly, withdrawal of the rejection of claim 10 as unpatentable over Sandelli et al., or Kougorou, in view of Hidekuni and further in view of Taylor is respectfully requested.

Conclusion

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

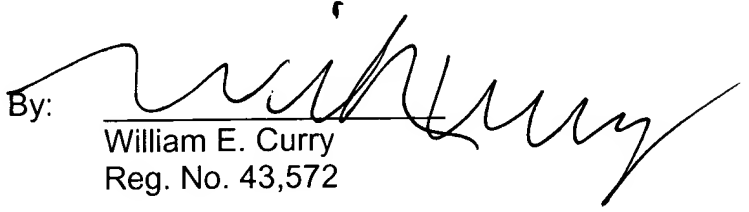
The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Dated:

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